

REMARKS

Claims 25-27 and 30-47 are pending. No new matter has been added by way of the present amendments. For instance, claim 25 has been amended to remove the recitation of “at least one”, and the recitation of “107th Met” and to further recite “and optionally an additional substitution of an amino acid residue at 107th Met with another amino acid residue.” This latter limitation is supported by Example 8 starting at page 25 of the present specification. Claim 26 has been amended to include additional recitations of specific amino acid residue substitutions. Claim 26 has also been amended to alter its dependency. Claims 30, 31, 32, 33, 34, 35, 42, 43 and 45 have been amended to clarify the claim language. Also, the dependency of claim 46 has been altered. Lastly, newly added claim 47 is supported by currently pending claim 25 except a limitation concerning the number of mutations has been added. Accordingly, no new matter has been added.

Applicants further submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner. In particular, Applicants have simply amended the claims so as to clarify the present invention and to remove issues. Thus, no new issues have been raised.

In the event the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objections to the Claims

At page 2 of the outstanding Office Action, the Examiner has objected to various claims. Applicants respectfully traverse.

First, the Examiner has objected to claims 26 and 27 asserting that improper claim identifiers have been used. This issue has been corrected in the present amendment.

Second, the Examiner has objected to claims 30-35, 43 and 45 asserting that the recitation of “the substitution... with another amino acid, respectively” is unclear since without the recitation of the “another” amino acid, “respectively” is unnecessary. Applicants traverse and submit that the objectionable language has been removed. Thus, this objection is moot.

In view of the above, Applicants respectfully request that the Examiner withdraw these claims objections.

Issues Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 25, 26, 33-35 and 39-42 under 35 U.S.C. § 112, first paragraph, for allegedly containing “new matter.” Applicants respectfully traverse this rejection.

The Examiner has asserted that there is insufficient support in the present specification for a “single” substitution at the 107th Met with either leucine or any other amino acid. Applicants respectfully submit that the “single” substitution at the 107th Met has been removed from the claims. However, referring to Example 8 starting at page 25 of the specification, Applicants point out that the 107th Met residue may be substituted with leucine, in combination with other mutations. Thus, as recited in the present claims, the combination substitution of the 107th Met with other possible substitutions is fully supported.

The Examiner has also rejected claim 42 for allegedly encompassing a single mutation and a substitution of the amino terminal sequence. The Examiner has asserted that the specification only provides support for the mutations and substitutions of the amino terminal sequence. Applicants traverse and submit that claim 42 has been amended to specify the number of substitutions.

In view of the above, Applicants respectfully submit that there exists no issues of “new matter” with respect to the pending claims. The Examiner is therefore respectfully requested to withdraw these rejections.

The Examiner has also rejected claims 25 and 26 for the recitation of “at least one” mutation asserting that the claim encompasses an unlimited number of mutations, which is not allegedly enabled by the present specification. Applicants respectfully traverse.

As discussed above, claim 25 has been amended so as to be reflective of the presently claimed subject matter. That is, claim 25 relates to a specific mutant α -amylase which is fully enabled by the present specification. That is, those of skill in the art, would not be placed under a burden of undue experimentation to make and use the presently claimed subject matter. Accordingly, the Examiner is respectfully requested to withdraw this enablement rejection.

Issues Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 42 and 46 under 35 U.S.C. § 112, second paragraph, for the reasons recited at pages 6 and 7 of the outstanding Office Action. Applicants respectfully traverse these rejections.

First, the Examiner has asserted that claim 42 is drawn to a mutation selected from a group of specific mutations and the substitution of an amino terminal sequence. Thus, the Examiner asserts that claim 42 is drawn to a single specific mutation and the substitution of amino terminal sequence. Applicants traverse and submit that claim 42 has been amended to clarify this issue.

Second, the Examiner asserts that claim 46 is confusing in its dependency upon claim 44. Applicants traverse and submit that claim 46 has been amended to depend upon claim 45.

In view of the above, Applicants respectfully submit that the present claims fully satisfy the requirements of 35 U.S.C. §112, second paragraph. Accordingly, the Examiner is respectfully requested to withdraw these rejections.

Allowable Subject Matter

At page 7 of the outstanding Office Action, the Examiner has indicated that claim 27 is allowable. Further, in view of the above, Applicants respectfully submit that in addition to claim 27, all other currently pending claims are likewise allowable. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow all currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Reg. No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of one (1) months to June 23, 2005 in which to file a reply to the Office Action. The required fee of \$120.00 is enclosed herewith.

Application No.: 09/590,375

Docket No.: 2173-0120P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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